UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,646	09/25/2001	Kerry R. Gaston	36767/257798	9270

23460	7590	01/11/2006

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EXAMINER
GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)   Office Action Summary   Part of Paper No./Mail Date 20051230 .

DETAILED ACTION

Response to Arguments

1.   With respect to claims 1-11 and 16 Applicant argues that Paolini does not teach or suggest each element of the independent claims 1 and 16. Examiner respectfully disagrees with this assessment and points out that while there may be some technical differences between the Applicant' invention and Paolinu, all of the limitations of the instant claims are met by Paolini. For example:

the limitation "establishing a communication channel between the client platform and the server platform" is met by connecting a client computer to a software source (see column 8, line 33). The limitation "retrieving a plurality of identifying indicia associated with the client platform" is met by receiving at least one unique central processing unit (CPU) identifier from said client computer (see column 8, line 35). The limitation "formatting the identifying indicia to create a unique user identifier associated with the client platform" is met by combining the at least one unique CPU identifier and a predetermined value associated with said software source to generate an encryption key at said software source (see column 8, lines 36-40). The limitation "embedding at the server platform the unique user identifier into the software application program" is met by encrypting a portion of the software utilizing the encryption key (created from the CPU identifier) - see column 8, line 41-42.

2.   Referring to claims 12, 13 and 15, Applicant argues that the combination of Paolini and Kubota is improper since it lacks any motivation in the art. Examiner also disagrees with this statement and points out that the motivation to combine the references is found

in Kubota (see at least Fig. 2 of Kubota). Contrary to the Applicant's belief, Paolini does

not already teach making determination to either decode (i.e. decrypt) the software or

generate an error code. Therefore, the combination of Paolini with Kubota does render

the instant claims obvious.

3.   In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary

skill in the art would have been motivated to modify the system for secure distribution of

software of Paolini, which uses hardware ID for software encryption, by adding the

functionality for comparing the unique user identifier of the client with the ID stored in

the server platform as taught in Kubota for making determination to either decode (i.e.

decrypt) the software or generate an error code (see Fig. 2 of Kubota).

4.   The rejections of claims 1-16 are maintained in view of the reasons provided

herein

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

6. Claims 1-11, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by

Paolini (U.S. Patent No. 6.847.948 B1).

7. Referring to the instant claims, Paolini discloses a method and apparatus for

secure distribution of software (see abstract). Paolini teaches that an identification code

provided by a client computer is combined with a pre-determined number provided by

the source of software or data to be copied to generate at least one unique encryption

key. Prior to each use the encrypted program re-derives the original encryption key,

which includes the identification code of the client computer, to decrypt the critical files

prior to use. The identification code may be a unique identifier associated with the client

computer such as a network identifier or a processor ID provided by the client computer

(see abstract).

8. Referring to the independent claim 1 and 16, the limitation "establishing a

communication channel between the client platform and the server platform" is met by

connecting a client computer to a software source (see column 8, line 33). The limitation "retrieving a plurality of identifying indicia associated with the client platform" is met by receiving at least one unique central processing unit (CPU) identifier from said client computer (see column 8, line 35). The limitation "formatting the identifying indicia to create a unique user identifier associated with the client platform" is met by combining the at least one unique CPU identifier and a predetermined value associated with said software source to generate an encryption key at said software source (see column 8, lines 36-40). The limitation "embedding at the server platform the unique user identifier into the software application program" is met by encrypting a portion of the software utilizing the encryption key (created from the CPU identifier) - see column 8, line 41-42. The limitation "transmitting the software application program from the server platform to the client platform" is met by transmitting the encrypted portion of the software to the client computer (see column 8, lines 43-44). The limitation "installing the software application program on the client platform" is taught by Paolini, because the software is transmitted in an .exe form and has to be installed before use.

9.   Referring to the independent claim 16 the limitation "UUI from client platform" is met by unique CPU identifier.

10.   Referring to claims 3 and 10, Paolini teaches an encrypted communications channel because the data transmitted is in encrypted form.

11.   Referring to claims 4, 5, Paoliny teaches that identifying indicia is an identification number of client's CPU and hardware identifier.

12.   Referring to claim 6, 8 Paoliny teaches concatenating the identifying indicia.

Paoliny inherently teaches formatting identifying indicia as a hexadecimal string

because transmission of the binary string would not work due to possible loss of data.

Therefore using MD5 for 16-bit words is inherent as well.

13.   Referring to claim 9, Paoliny meets the limitation "transmitting each encrypted

file associated with the software application program to the client platform; and

transmitting the encryption key to the client platform" by transmitting the encrypted

portion of the software to the client computer (see column 8, lines 43-44).

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.   Claims 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Paolini (U.S. Patent No. 6.847.948 B1) in view of Kubota (U.S. Patent No.

5.034.980).

16.   Referring to the instant claims, Paolini discloses a method and apparatus for

secure distribution of software (see abstract). Paolini teaches that an identification code

provided by a client computer is combined with a pre-determined number provided by

the source of software or data to be copied to generate at least one unique encryption

key. Prior to each use the encrypted program re-derives the original encryption key,

which includes the identification code of the client computer, to decrypt the critical files

prior to use. The identification code may be a unique identifier associated with the client

computer such as a network identifier or a processor ID provided by the client computer

(see abstract). Paolini teaches detecting the ID and rederiving the encryption key from

it (see Fig. 2 B), he does not explicitly teach comparing the unique user identifier with

the each unique user identifier stored in the memory associated with platform server.

17.   Referring to the instant claims, Kubota discloses a microprocessor for providing

copy protection (see abstract and Fig. 1). Kubota teaches that if the software is copy

protected, then the program will read the value of the ID in register 11 and make a

comparison to the ID value stored in the software. If there is a match, then the software

continues to execute its routines and activates the mode register 17 to select the routing

through decoder 15, such that routines from the software are passed through decoder

15. The key in decoder 15 deciphers the encrypted software and proper instructions are

retrieved only when the intended microprocessor having the appropriate key is used

(see Fig. 2 and column 4, lines 4-15).

18.   Therefore, at the time the invention was made, it would have been obvious to

one of ordinary skill in the art to modify the system for secure distribution of software of

Paolini, which uses hardware ID for software encryption by adding the functionality for

comparing the unique user identifier of the client with the ID stored in the server

platform as taught in Kubota. One of ordinary skill in the art would have been motivated

to modify the system for secure distribution of software of Paolini, which uses hardware

ID for software encryption, by adding the functionality for comparing the unique user

identifier of the client with the ID stored in the server platform as taught in Kubota for

making determination to either decode (i.e. decrypt) the software or generate an error

code (see Fig. 2 of Kubota).

19.   Referring to claim 15, the limitation "determining that the first control program has

been previously executed" is met by determining if the ID's match as taught in Kubota,

which means that the software is encrypted and the first control program was executed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Grigory Gurshman whose telephone number is

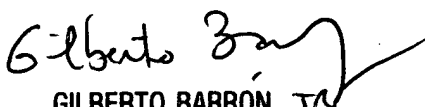(571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number

for the organization where this application or proceeding is assigned is 571 273 8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Grigory Gurshman
Examiner
Art Unit 2132

GG

GILBERTO BARRON JR
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